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IN THE
Supreme Court of the United States

OCTOBER TERM, 1941

No. 1024

TAMPAX INCORPORATED and TAMPAX
SALES CORPORATION

Petitioners

vs.

THE PERSONAL PRODUCTS CORPORATION and
ISIDORE H. SCHWARTZ, trading as HIGHLAND
PHARMACY

Respondents

REPLY BRIEF FOR PETITIONERS

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The sole answer of respondent to the petition for certiorari is the assertion that the question stated to be presented by the decision of the Circuit Court of Appeals for the Second Circuit was not in fact presented by that decision. This is a question of fact. There can be no disagreement about a fact. There may be a mistake of fact and therefore an innocent misstatement of it. Respondent's counsel before this Court represented respondent in the Circuit Court of Appeals and it is difficult to believe that they are ignorant as to the questions decided by the Circuit Court of Appeals in its decision. We are therefore constrained to believe that the assertion that the stated ques-

tion is not presented by the decision of the Circuit Court of Appeals is made solely because of the unfamiliarity of this Court with the record.

Petitioner did not anticipate that respondent's answer would raise a controversy as to record facts, and we are therefore filing this reply to respondent's brief to aid the Court in making such examination of the record as may be necessary to determine the truth or falsity of respondent's statement.

The following are the record facts which admit of no dispute. The application of the Haas original patent No. 1,926,900 (R. 188) disclosed no convolutions at all, either "regular" or "haphazard". In the prosecution of that application Haas presented a claim (Cl. 17, R. 279), wherein he introduced convolutions for the first time, but with no limitations to *regular* convolutions as distinguished from *haphazard* convolutions. The claim was rejected in that application on the ground that there was no basis for the claim in the disclosure—no convolutions of any kind being illustrated or described (R. 282). The patentee cancelled the claim without prejudice to its presentation in a continuing application (R. 286), and promptly filed the application for the patent in suit (R. 180, 191, 201) with a claim identical with the claim cancelled from the first application and with the specification amplified to show and describe the *regular convolutions* resulting from the method of manufacture then employed by the patentee. This additional matter describing the regular convolutions is what the Circuit Court of Appeals for the Second Circuit has designated in their opinion as the "second passage", and it was the introduction of this second passage on which the Court of Appeals based its ruling that the claim was limited to *regular convolutions*, and therefore excluded the haphazard convolutions of the defendant's tampon, notwithstanding the broader language of the claim itself. In the language

of the Court's opinion the patentee "by the introduction of Figure Two and the 'second passage' . . . introduced the element that the 'convolutions' must be *regular zig-zags*" (R. 506, emphasis ours).

The error of the Court of Appeals is expressed in this statement and the one immediately following: "Obviously it made no difference that this limitation was incorporated into the claim *only by reference*" (R. 506, 507, emphasis ours).

A claim defining an element broadly as a "convoluted strip" should not be construed as limited to "regular zig-zag" convolutions by the addition to the specification and drawings of the disclosure of a particular form of convoluted strip wherein the convolutions were regular zigzags.

It is petitioner's contention that the Court of Appeals was in error in holding that "the introduction of Figure Two and the 'second passage' " in the specification of the continuing application "incorporated into the claim" any limitation "by reference" or otherwise. It is this error of the Circuit Court of Appeals for the Second Circuit which petitioner asks this Court to review. The petition accurately states the question thus erroneously decided.*

In stating the contrary, on page 2 of its brief, respondent has disregarded both the record facts and the plain language of the Court's opinion. Petitioner did not, as here stated by respondent, contend that the patent claim "should be construed as though the 'convoluted' limitation were absent". The opinion of the Court of Appeals correctly expresses petitioner's contention, namely, that the claim is not confined by the expression "convoluted" to

*Does the amplification of the specification and drawing, whether by amendment or by a "continuing" application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details? (Petition, p. 3).

"regular zigzag folds" as distinguished from haphazard folds, but the Circuit Court of Appeals decided against petitioner because of the alleged file wrapper estoppel.

It is not denied by respondent that the decision of the Circuit Court of Appeals, so construed, is directly contrary to the ruling of the decisions of the Courts in the First and Third Circuits, referred to on page 4 of the petition, and also in direct conflict with the doctrine of file wrapper estoppel as expressed by this Court in *Exhibit Supply Co. v. Ace Patents Corporation* (decided February 2, 1942) as alleged in our petition.

Respectfully submitted,

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Dated: New York, N. Y.

April 2, 1942.

